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In re Application of
O'Regan et al.
Application No.: 10/534,206
PCT No.: PCT/IE03/00150
Int. Filing Date: 06 November 2003
Priority Date: 07 November 2002
Attorney Docket No.: 3583 P 007
For: System For Billing Rating
And Selection Of Accounts

DECISION
ON
PETITION

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 26 January 2007.

DISCUSSION

In a Decision mailed on 27 September 2006, the petition under 37 CFR 1.47(a) filed on 30 January 2006 was dismissed without prejudice because

Counsel suggests that Mr. Mullins is "unavailable" to execute the declaration, and alludes to a written "refusal" by Mr. Mullins (allegedly appearing in e-mail correspondence to a Jo Wall). However, counsel has not furnished a copy of such e-mail correspondence; instead, it is merely referenced by the petition and by the attached copy of a letter sent to Mr. Mullins dated 12 December 2005. Given the highly probative nature of such evidence, petitioner is required to furnish a copy of the e-mail correspondence in question. Moreover, the evidence of record does not show that a complete copy of the application papers was provided to Mr. Mullins for his consideration in deciding whether to execute the declaration. Thus, Mr. Mullins' alleged failure to respond to the letter of 12 December 2005 does not constitute a refusal to execute the oath or declaration within the meaning of 37 CFR 1.47(a).

Regarding requirement (4), the petition is accompanied by declaration documents signed by joint inventors Michael O'Regan and Ian Deakin on behalf of themselves and non-signing joint inventor Robert Mullins. Inspection of the document signed by Michael O'Regan reveals that it is defective because there has been an uninitialed and undated change to his residential address; therefore, it is unclear whether the change was made after he signed the declaration. Moreover, due to said change, the declaration does not include an indication of the country where his residential and mailing addresses are located. Therefore, requirement (4) has not been satisfied.

In response, petitioner has furnished additional evidence purporting to show that Mr. Mullins refused to execute the declaration, including a declaration made by Jo Wall on 16 January 2007 and supporting documentation, including emails from Mr. Mullins. However, the record still does not clearly show that Mr. Mullins was presented with a complete copy of this application prior to the alleged refusal to execute the application. The letter to Mr. Mullins dated 21 November 2006 refers to a "copy of the published PCT Patent Specification." but the

specific international application number of the application sent to Mr. Mullins is not specified. Moreover, it is not clear whether a complete copy was sent, or just a "Specification" (i.e., description, without claims, drawings or abstract). In addition, the letter suggests that the "Specification" was sent by Michael Lucey rather than by Jo Wall, but petitioner has not provided a statement by Mr. Lucey describing his first-hand knowledge of the circumstances surrounding the transmittal of the "Specification." As noted in the Decision mailed on 27 September 2006, MPEP 409.03(d) states that a proper showing of "refusal" requires proof that a bona fide attempt was made to present a complete copy of the application papers to the non-signing inventor. Since this point has not been proven, requirement (2) still has not been met.

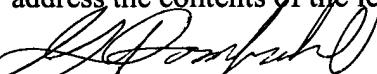
Petitioner has also provided a new declaration of inventorship signed by Michael O'Regan. This declaration cures the defects noted in the previous decision; as such, requirement (4) has now been satisfied.

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.


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